

REMARKS

Reconsideration of the rejections set forth in the Office Action mailed August 15, 2003, is respectfully requested. Claims 1-13 remain pending in this case.

Double Patenting

Claims 1-5, 8-11, and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-6 of U.S. Patent No. 5,769,816, claims 1-6 and 23-28 of U.S. Patent No. 6,086,605, and claims 1-5, 8-11, and 13 of U.S. Patent No. 6,136,016. (Please note that applicants believe that U.S. Patent No. 6,068,605 was listed in error in ¶ 3 on page 2, as this patent is not owned by Edwards. It is believed that the examiner was referring to U.S. Patent No. 6,086,605.) Without conceding the propriety of the rejections, applicants file a terminal disclaimer herewith.

Art Rejections

Claims 1-13 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Reger et al. (U.S. Patent No. 5,160,342). Applicants respectfully assert that Reger does not teach or suggest “a filter removably inserted through the lumen of the tubular member.” As described in Col. 6, lines 34-40, the filter elements are “*securely and tightly fastened*, as by an adhesive or thermal weld, to the interior of a tubular stocking 60.”

Claims 1-13 were also rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Barbut et al. (U.S. 5,769,816). Applicants note that Denise Barbut, one of the inventors now named on the present application, was also named on the ‘816 patent. Moreover, applicants submit herewith a Declaration of Denise Barbut and Tracy Maahs under 37 C.F.R. § 1.132 that

establishes that the invention claimed herein was disclosed but not claimed in the '816 patent. Thus, the '816 patent is not prior art to this application. See MPEP Section 716.10 and 715.01(a) ("When subject matter, disclosed but not claimed in a patent issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent and relied on in the rejection.") *In re DeBaun*, 687 F.2d 459, 214 U.S.P.Q. 933 (CCPA 1982). Denise Barbut and Tracy Maahs invented that portion of the subject matter disclosed in the '816 patent that is relied on in the rejection. Barbut and Maahs Decl., ¶ 5. Therefore, the rejection under 35 U.S.C. §102(e) for alleged anticipation should be withdrawn. Therefore, Applicants respectfully request withdrawal of the rejections and reconsideration of the claims.

For all the foregoing reasons, Applicants assert the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicants' undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
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